

REMARKS

This submission is made in response to the Examiner's Non-Final Office Action dated February 24, 2006. Claims 1-7 are currently pending in the instant application. Applicant and the undersigned are most grateful for the time and effort accorded to the instant application by the Examiner. The Examiner is respectfully requested to reconsider the rejections present in the outstanding Office Action in light of these amendments and the following remarks.

Rejections under 35 U.S.C. Sec. 112 First Paragraph:

Claim 5 stands rejected under 35 U.S.C. Sec. 112 First Paragraph for lack of enablement. Specifically, the Examiner states that the specification does not adequately support the limitation of "subscription manager for . . . generating a new license key at the information terminal of said user for said downloaded program." The phrase "at the information terminal of said user" has been deleted from the claim as indicated in the listing above. Applicant respectfully submits that the specification adequately supports the limitation of a subscription manager that generates a license key for a downloaded program. Applicant respectfully requests that the Examiner withdraw this rejection in view of the above mentioned amendment.

Rejection under 35 U.S.C. Sec. 112 Second Paragraph:

Claims 2 and 3 stand reject under 35 U.S.C. Sec. 112 Second Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states that it is unclear if

the method steps recited in the claims following the limitation of “. . . where said program key is not found to be present transmitting, when said user selects a file for downloading an article on said service menu, a request for a connection with a file server from said information terminal of said user to said network provider; . . .” are performed when the program key is not found to be present. Applicant respectfully disagrees with the Examiner’s assessment.

The method step limitations of Applicant’s claimed method are listed sequentially and refer to the previous step in the sequence. For instance, the next step in the claimed method refers to the connection request related in the limitation in question, the step after that refers to the file downloading service menu related in the prior step. The claimed sequence is therefore distinctly and particularly set forth in the claims. Applicant respectfully requests that the Examiner withdraw this rejection.

Claims 2 and 3 stand rejected under 35 U.S.C. Sec. 112 Second Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states that the phrase “specified downloaded program information” is unclear because the elements making up this information cannot be identified by the Examiner. The Examiner’s rejection states that claim 1 is rejected according to this reason but claim 1 does not contain the above mentioned terminology. Applicant believes this is a typo and that the Examiner meant to refer to claim 2. It seems that the Examiner is confused as to whether the word “specified” is meant to refer elements previously claimed and therefore requiring antecedent basis. Applicant has amended claims 2 and 3 refer to “downloaded

program specifying information” so as to alleviate any confusion about lack of antecedent basis and to make the claim terminology more consistent. Applicant respectfully requests that the Examiner withdraw this rejection.

Claims 2 and 3 stand rejected under 35 U.S.C. Sec. 112 Second Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states that there is insufficient antecedent basis for “said program file” in the claims. The claims have been amended as indicated above to provide proper antecedent basis for the terminology in question and to make the claim terminology more consistent. Applicant respectfully requests that the Examiner withdraw this rejection.

Claims 2 and 3 stand rejected under 35 U.S.C. Sec. 112 Second Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states that “transmitting said downloaded program information from said information terminal of said user to said network provider” is unclear because it is unclear as to how the downloaded program specifying information is sent to the information terminal. The Examiner is seemingly making this rejection on the basis that the subject matter in question is essential to the claim. However, the Examiner has not pointed out why this subject matter is necessary or essential to the claim in light of the specification or leads to lack of enablement for the claim. MPEP Sec. 2172.02. Applicant respectfully requests that the Examiner withdraw this rejection.

The Examiner's Office Action contains a truncated paragraph under the heading for rejections under 35 U.S.C. Sec. 112 but no grounds of rejection are given. This seems to be a typographical error and will not be specifically addressed.

Rejections under 35 U.S.C. Sec. 103(a):

Claims 1-7 stand rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over U.S. Patent 5,925,127 to Ahmad.

As best understood, Ahmad appears to be directed to a method for monitoring the validity of software that is rented to a user from an Internet site. (Col. 2, lines 11-19) The method seems to be accomplished through a process whereby a user downloads three (3) modules: a Check-in/Check-out (CICO) module; a Software Monitor (SM) module; and a program module. The CICO appears to supply relevant licensing information to the program module via the SM. The SM in turn, appears, to enable or disable the program according to the current licensee, as well as tracking the use of the program when the licensed information is found to allow for the program modules use. A user desiring to rent some particular software module will first access an Internet location where the appropriate contract and payment can be made, afterwards, the modules are downloaded. After the allotted rental time has expired the user can "[r]e-rent the program module for subsequent use. For subsequent rental of the program module by the user, there is no need to download the program module from the rental service provider's server, but a new CICO module must be downloaded from the real service provider's server for such subsequent rentals of the program module." (Col. 14, lines 67 - Col. 15, lines 5) The

Ahmad invention focuses upon overcoming the problem of monitoring rented software.

(Col. 15, lines 6-8)

Broadly, the instantly claimed invention provides a method and system for the distribution of free software by an Internet provider to and for the use of its customers during the time in which the user remains a customer of the Internet provider. However, should the user end its relationship with the Internet provider, the present invention also provides a method for ensuring that the continued use of the software by the user is no longer possible; furthermore, the presently claimed invention, also, provides a way in which the licensing information required for use of the provided software can be updated upon the connection of the user to the Internet Service Provider.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP Sec. 2143.

With regards to the rejection of claim 1, the claim sets out the step of transmitting to the information terminal of the user either a license key that is referred to when a downloaded program is activated or executed and that disables at least a part of the function of the program when the program matches a predetermined license condition, or information with which the license key can be generated at the user's information

terminal. The Examiner states that this element corresponds to the CICO module disclosed in Ahmad ('127). Applicant respectfully disagrees. The CICO module disclosed by Ahmad ('127) is merely a software module that conveys certain information to a software monitor located on a user's terminal. Once this function is completed the CICO module is deleted (col. 10 lines 21-67). The CICO module disclosed by Ahmad ('127) does not function to disable at least a part of the function of a program when the program matches a predetermined condition, as is currently claimed. Nor could it, since by the time any such condition is met the CICO module has been deleted. Moreover, a CICO module cannot be generated at the user's terminal. A CICO module can only be obtained by downloading one from a service provider's server (col. 11 lines 55-65). The Examiner has not pointed out any feature disclosed by Ahmad ('127) or other relevant prior art that corresponds to the license key claimed by the Applicant in claim 1. Applicant respectfully submits that claim 1 is allowable over Ahmad ('127) for at least these reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 1 under Sec. 103(a) as being unpatentable over Ahmad ('127).

With regards to the rejection of claim 2, the claim sets out the steps of transmitting to the user's information terminal information from which a new license key can be generated and then generating a new license key at the user's information terminal. The Examiner states that these steps correlate to the generation of licensing info and the transmission of licensing info from a CICO module to a software monitor and to a program module disclosed in Ahmad ('127). Applicant respectfully disagrees. Ahmad ('127) does not disclose that new licensing info is generated from information transmitted

to the user's information terminal and then actually generated at user's information terminal. Rather the licensing info disclosed by Ahmad ('127) is included within a CICO module that can only be obtained by downloading from a service provider's server (col. 10 lines 21-34 & col. 11 lines 55-65). The CICO module transmits this licensing info to a software monitor and is then deleted. The licensing info is then transmitted from the software monitor to a program module when the program module is activated. This is not new licensing info generated at the user's information terminal but rather the same licensing info that was transmitted to the software monitor by the CICO module. The only way to obtain new licensing info is to download a new CICO module from the service provider's server (Fig. 4 & col. 10 line 21-col. 12 line 10). The Examiner has not pointed out any method steps disclosed by Ahmad ('127) or other relevant prior art that corresponds to the steps for generating a new license key at a user's information terminal claimed by the Applicant in claim 2. Applicant respectfully submits that claim 2 is allowable over Ahmad ('127) for at least these reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 2 under Sec. 103(a) as being unpatentable over Ahmad ('127).

With regards to the rejection of claim 3, the claim sets out the steps of transmitting to the user's information terminal information from which a new license key can be generated and then generating a new license key at the user's information terminal. The Examiner states that these steps correlate to the generation of licensing info and the transmission of licensing info from a CICO module to a software monitor and to a program module disclosed in Ahmad ('127). Applicant respectfully disagrees. Ahmad

(‘127) does not disclose that new licensing information is generated from information transmitted to the user’s information terminal and then actually generated at user’s information terminal.

Rather the licensing information disclosed by Ahmad (‘127) is included within a CICO module that can only be obtained by downloading from a service provider’s server (col. 10 lines 21-34 & col. 11 lines 55-65). The CICO module transmits this licensing info to a software monitor and is then deleted. The licensing information is then transmitted from the software monitor to a program module when the program module is activated. This is not new licensing information generated at the user’s information terminal but rather the same licensing information that was transmitted to the software monitor by the CICO module. The only way to obtain new licensing information is to download a new CICO module from the service provider’s server (Fig. 4 & col. 10 line 21-col. 12 line 10). The Examiner has not pointed out any method steps disclosed by Ahmad (‘127) or other relevant prior art that corresponds to the steps for generating a new license key at a user’s information terminal claimed by the Applicant in claim 3. Applicant respectfully submits that claim 3 is allowable over Ahmad (‘127) for at least these reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 3 under Sec. 103(a) as being unpatentable over Ahmad (‘127).

With regards to the rejection of claims 4-7, these claims, like claim 1, all contain the element of a license key that is referred to when a program is activated or executed and which disables at least a part of the function of the program matches a predetermined license condition or can be generated at the user’s information terminal. Applicant

respectfully submits that these claims are allowable over Ahmad ('127) for at least the reasons discussed above with regards to claim 1. Applicant respectfully requests that the Examiner withdraw the rejection of claims 4-7 under Sec. 103(a) as being unpatentable over Ahmad ('127).

Response to Examiner's Remarks:

With regards to the Examiner's remark that the features of the license key are claimed in the alternative and as such the claim can be rejected on the basis of one alternative being set out in the prior art, the Applicant respectfully submits that neither claimed alternative is disclosed by Ahmad ('127) as previously discussed with regards to the rejection of claim 1 under Sec. 103(a). As such Applicant respectfully submits that Ahmad ('127) cannot serve as the basis for rejecting such subject matter even according to the broadest interpretation of the claims.

With regards to the Examiner's remark that Applicant has failed to set forth how generating a license key at a user's terminal is patentably distinct from generating a license key which is then transmitted to a user's terminal, the Applicant respectfully submits that in order to establish a *prima facie* case of obviousness a prior art reference or combined prior art references must set forth all the claimed elements. MPEP Sec. 2143. Ahmad ('127) does not set forth this element nor has the Examiner pointed to any other prior art references that do. Moreover, the Applicant respectfully submits that the Examiner has not set forth any reason for considering these differences to be patentably *indistinct*.

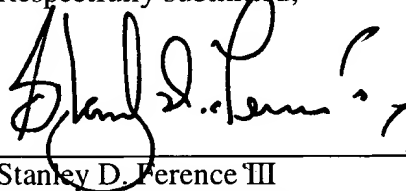
With regards to the Examiner's remark that Applicant has failed to show support within the specification for certain amendments to the claims, the Examiner's attention is directed to the first paragraph on page 24 of the specification which states:

However, a program for generating and registering the L-Key 121 may be transmitted by the provider 110 to the user, and the user may generate the L-Key 121. In this case, the L-Key 121 may be generated based on information that is provided for specifically identifying an apparatus that executes a program.

Applicant respectfully submits that this excerpt provides proper support for the amendments in question.

In view of the foregoing, it is respectfully submitted that Claims 1-7 are fully distinguishable over the applied art and immediately allowable. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Stanley D. Ference III
Registration No. 33,879

Customer No. 35195
FERENCE & ASSOCIATES
409 Broad Street
Pittsburgh, Pennsylvania 15143
(412) 741-8400
(412) 741-9292 - Facsimile

Attorneys for Applicant